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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/878,518 | 06/11/2001 | Paula F. Delano | END920010011US1 | 4253 |

23550 7590 07/02/2008
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| EXAMINER |
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ROBERTSON, DAVID

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| ART UNIT | PAPER NUMBER |
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3623

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

07/02/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/878,518 | Applicant(s) DELANO ET AL. | |
| | Examiner Dave Robertson | Art Unit 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,11-22,24-27,29-32,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,11-22,24-27,29-32,34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a Non-final office action in response to Applicant's reply of 3/31/2008. Claims 1, 4-9, 11-22, 24-27, 29-32, 34 and 35 are pending. This action is non-final due to new grounds of rejection entered under 35 USC § 101.

Response to Amendment

2. Applicant amends claims to recite that the *business entity* is a banking entity and that one of the software application needs is obtaining real-time transaction of data for on-line banking transactions.

Response to Arguments

3. Applicant's arguments filed 3/31/2008 have been fully considered but they are not persuasive:

4. Applicant argues none of Puri, Barritz, Fuerst or Canada teaches the features recited in claim 1 as related to *banking entities*. Applicant asserts that the claim no longer recites *a banking entity* as merely an intended use. (Remarks, page 15).

Examiner respectfully disagrees. Recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The invention as claimed is a method of analyzing software application needs including the functional steps of: *inventorying a set of application in use; formulating a*

set of questions related to the software application; weighting possible responses to the set of questions; receiving responses; and determining whether to remove the software application. That such applications inventoried and questions formulated may be related to a *banking entity*, or even specifically to the priority of *obtaining real-time transaction of data for on-line banking transactions*, the steps of *inventorying, formulating, weighting, receiving, and determining* are not changed by nature of the applications inventoried or questions formulated. Therefore, there is no apparent structural or functional difference between performing the method *wherein the business entity is a banking entity*, compared to any other business entity.

5. Applicant continues to contend that the use of four references is “unfathomable” (Remarks, page 16), and submits “that the combinations that underlie the Office’s rejections are flawed.” (Remarks, page 16).

In response, Examiner reasserts that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Further, Applicant provides no specific argument as to the lack of motivation or suggestion to combine for any element asserted. Applicant's argument is conclusory: no error on the part of the Examiner is specifically shown for any findings made as to the combinations asserted.

6. Accordingly, the rejections of the prior office action are maintained.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 4-9, and 11-15 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions. For a process to be patentable subject matter under § 101 the process must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform subject matter to a different state or thing. See *Diamond v. Diehr*, 450 US 175, 184 (1981); *Parker v Flook*, 437 US 584, 588 n9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 US 780, 787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process. To qualify under § 101 as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the present case, the claims encompass steps of a process which may be carried out entirely by hand or in the human mind. Though the claims recite in the preamble *A computer-implemented method...* none of the steps of the method are positively tied to another statutory class, such as particular apparatus. And though the method involves analyzing information related to *information technology*, it is not positively recited that a particular apparatus involving information technology is used to

perform any of the recited steps. As such, the claims lack a sufficient tie to another statutory class and are therefore ineligible for patenting.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-9, 11-22, 24-27, 29-32, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri (U.S. 6,064,982) and Barritz et al. (U.S. 6,938,027) and further in view of Fuerst (U.S. 6,189,029) and Canada et al (U.S. 6,767,660).

Puri discloses, generally, automated methods and a system for surveying the software application needs of a customer to determine what features/options of an application software package are needed for a business entity and therefore worth purchasing from the software vendor. Barritz discloses automated methods for inventorying software applications of a business entity. Fuerst discloses an automated, general purpose web tool for creating arbitrary surveys with multiple choice questions including multiple choice and "range-type" responses. Canada discloses the use of such multiple response questions in surveying a business entity for an arbitrary strategy of the business entity.

As per claim 1, Puri discloses a computer-implemented method for analyzing software application needs of a business entity to determine whether to remove an entity software application, comprising the steps of: formulating a set of questions related to the entity software application based on a business strategy corresponding to the business entity, wherein the set of questions are tailored to assess the software application needs of the business entity and to measure how well the entity software application is meeting the software application needs (col. 1, lines 33-35 and 47-53; col. 3, lines 32-34; col. 5, lines 1-15 and 26-30; Figure 4; The system takes the business entity through a series of interactive questions to learn more about the application needs of the business entity. Item 52 in Figure 4 lists specific software application needs such as information publishing and electronic commerce. The business entity identifies its needs by checking the boxes (item 51 in Figure 4) most relevant to its needs. The needs assessment process measures how well the entity software application is meeting the software application needs of the business entity by recommending products that will actually meet the business entity's software application needs. In other words, a product is recommended only if it is determined in the needs assessment that the business entity needs the product, which means the business entity does not have a current product that meets that particular software application need (i.e., a current software application is not meeting the software application needs of the business entity well).); and receiving entity responses to the set of questions (col. 5, lines 3-8; Figures 4: entity responses are received through an interactive interface).

Puri does not expressly disclose inventorying a set of entity software applications that are *currently used by the business entity*. Although Puri does disclose a needs assessment through which a business entity identifies technology areas in which they desire software applications (see Figure 4). By identifying technology needs, such as a desire to enhance a web site (statement 4 in Figure 4), a business entity is identifying the hardware and software they are currently using (i.e., in order to have a functioning web site to begin with, certain hardware and software applications must be in use (such as web servers)).

Barritz discloses products that exist that inventory software products that have been installed on a computer system (col. 2, lines 47-55). Barritz also discloses a product for monitoring software products installed on a computer system and their usage (col. 6, lines 17-25). Puri and Barritz are analogous in that each is concerned with providing products/software applications to entities that entities will use based on their products/software applications needs/requirements. Identifying the software applications that a business entity is currently using, while also receiving their technology needs, provides a recommendation tool such as that of Puri with more comprehensive data to conduct a needs analysis and product recommendation. For example, if a business entity identifies a particular publishing application that it is currently using while also identifying publishing as a technology area that needs improvement, the recommendation tool would not recommend the publishing application that the business entity is currently using (at least not without some modification) as it obviously is not sufficient for the business entity's needs. Thus, at the time of the

invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to inventory a set of entity software applications that are currently used by the business entity as doing so provides the recommendation tool with more comprehensive data with which to conduct a needs assessment, thereby enhancing the analysis and ultimate product recommendation performed by the recommendation tool.

Puri also does not teach *weighting the possible responses where the weighting comprises assigning a value for each possible response to the set of questions, wherein there are at least three possible responses to the question in the set of questions.*

Whereas, Puri discloses weighting possible responses to the set of questions based on the business strategy by allowing an entity to identify needs that are important for its business (col. 5, lines 3-15; and Figure 4: the system weighting the response as indicative of a particular need and guiding the entity to answer more questions relating to that need, thereby emphasizing the need.); however Puri does not expressly teach there are at least three possible responses to each question or assigning a value to each possible response to the set of questions.

As is well-known in the art of survey design, Fuerst discloses an automated, general purpose web tool for creating arbitrary surveys with multiple choice questions including multiple choice and “range-type” responses (see Figure 8 and related discussion). Canada discloses an example of the use of such multiple choice and range-type “1=low to 5=high” responses in surveying a business entity for an arbitrary strategy of the business entity (see Canada Figure 3D and related discussion). It would have been obvious to one of ordinary skill in the art at the time of invention responses to

questions on a survey of the needs of a business entity, would have employed such multiple choice and range-type questions to further distinguish the gradation of the respondents' assessment of the need for a particular capability in the software application (as in Puri's example business need survey), thereby providing a more accurate and precise assessment of the need. Inherent to the implementation of such multiple choice and range-type questions, is the assigning of different values or weights to the responses to each question and using such weights in analysis of the survey responses.

Puri does not expressly disclose determining, based on entity responses, whether to remove the entity software application. Barritz discloses determining, based on entity responses, whether to remove the entity software application (col. 1, lines 32-35 and 40-46; col. 6, lines 25-29). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Puri to determine whether to remove an entity software application because doing so aids the entity in being more cost efficient and making better decisions about products it will use, as removing an entity software application is typically done when a software application is considered obsolete or underused (see Barritz, col. 2, lines 8-12; col. 6, lines 25-29).

As per claim 4, Puri discloses the method of claim 1, further comprising the step of analyzing the received responses to make a set of recommendations (col. 6, lines 5-13 and 43-46; The system provides recommendations to the entity based on the application needs assessment. The application needs assessment includes an

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interactive tool through which the entity selects from a predetermined question/answer session.).

As per claim 5, Puri discloses the method of claim 1, further comprising the step of generating a report based on the received entity responses (Figure 9).

As per claim 6, Puri discloses the method of claim 1, wherein the entity software applications are grouped by business process (item 42 in Figure 4 shows a business process grouping of the needs to be identified by the entity).

Claims 7-9, 11-22, 24-27, 29-32, 34 and 35 recite substantially similar subject matter as claims 1 and 4-6 above. Therefore, claims 7-35 are rejected on the same basis as claims 1 and 4-6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on 9 am to 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dave Robertson/

Examiner, Art Unit 3623

/Beth Van Doren/

Supervisory Patent Examiner, Art Unit 3623